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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,197	10/10/2000	Carl C. Kah III	P/3426-7 RE	6102

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EXAMINER

MORRIS, LESLEY D

ART UNIT	PAPER NUMBER
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3752

DATE MAILED: 02/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/686,197

Applicant(s)

KAH, CARL C.

Examiner

Lesley D Morris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on October 10, 2000; April 6, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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*Reissue Applications*

1. The examiner wishes to make the record clear as to the number of claims contained in this reissue. The reissue was filed on October 10, 2000, and contained claims 1-19 (with certain amendments) from the original patent and new claims 20-28. A preliminary amendment was filed on April 6, 2001, to make sure the claims agreed with the reexamination. Thus, the amendment contained claims 1 and 4-19 (including various amendments), claims 20 and 21 which were introduced during the reexamination and repeats the new claims now numbered as 22-30.

2. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,826,797 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation. Specifically, a copy of the Reexamination Certificate has not been provided.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

3. The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

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4. Claims 1, and 4-30 are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath/disclosure is set forth in the discussion above in this Office action.

5. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

6. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed. The supplemental oath/declaration should address the above mentioned defect as well as the preliminary amendment that was filed April 6, 2001.

***Information Disclosure Statement***

7. The IDS filed April 6, 2001 and the preliminary amendment filed April 6, 2001 are hereby acknowledged and have been placed of record. Since a PTO-1449 was not provided as part of the IDS, the Bendall patent will be listed on a PTO-892.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original disclosure of the Patent does not provide support for the nozzle

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plate having insertable nozzles inserted into the plate. The disclosure merely calls for the nozzle plate to have a nozzle.

10. Claims 1, 4-15, 20, and 22-30 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

During the prosecution of application 08/405033 (Patent 5,826,797) an amendment was filed August 8, 1996 adding the following limitation to independent claim 1 and including such limitation in independent claim 12: "sealing means surrounding the discharge end of a water passage formed in said nozzle housing; said sealing means including a seal member...".

According to Applicant's arguments accompanying this amendment, this change occurred to more specifically define the seal of the instant invention from the prior art. Since this limitation was added in response to a rejection of the claims, the removal of such limitation is considered to be recapture.

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During the prosecution of application 08/405033 (Patent 5,826,797) an amendment was filed January 15, 1997 adding the following limitation to independent claim 1: "means for retaining said nozzle selection sleeve in place". The next action was a Notice of Allowability. Since this limitation was added in response to a rejection of the claims, the removal of such limitation is considered to be recapture even though that limitation is not specifically mentioned by Applicant or the examiner.

During the prosecution of application 08/405033 (Patent 5,826,797) an amendment was filed August 8, 1996, that added new claims 23-26 that were said to be limited to the combination of the nozzle housing and riser where the nozzle selection is mounted to surround the nozzle housing to rotate therewith and relative thereto. Such combination was deemed to make the claims allowable. New claims 22-30 in this reissue application are deemed to be broader than patented claims 16-19 (which relate to the claims that were numbered 23-26 during the prosecution of application 08/405033) because they do not call for the nozzle selection to surround the nozzle housing and riser. Since this limitation was added in response to a rejection of the claims and deemed to be allowable, the removal of such limitation is considered to be recapture.

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Balister, Beamer, Kah Jr. 4,867,378., Kah Jr. 5,098,021, Kah Jr. 5,104,045, Han et al., and Lindermeir et al. were all cited in the Patent. Meshberg and Walker et al. were cited in the reexamination. Simonetti et al. and Hunter both show pattern sprinklers.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lesley D Morris whose telephone number is (703) 308 0629. The examiner can normally be reached on Monday-Thursday (7:30-4:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Yuen can be reached on (703) 308 1946. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872 9302 for regular communications and (703) 872 9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0861.

*Lesley D. Morris*

Lesley D Morris  
Primary Examiner  
Art Unit 3752

LDM  
February 4, 2002